

### **REMARKS**

Claims 1-13, 28, and 30-31 are currently pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 9, and 28 have been rewritten to further clarify the embodiments of the present invention recited therein. In addition, various dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. As no new matter has been added, Applicants respectfully request entry of these amendments at this time.

### **THE REJECTIONS UNDER 35 U.S.C. § 112**

Claims 6 and 9-13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for the reasons provided on page 2 of the Office Action. In response, both claim 6 and claim 9 has been rewritten to clarify the invention claimed therein.

In light of these amendments, Applicants respectfully submit that the § 112 rejections have been overcome. Reconsideration and withdrawal is respectfully requested.

### **THE REJECTIONS UNDER 35 U.S.C. §§ 102 & 103**

Claims 1-3 and 6-8 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,018,012 to Crast ("Crast") for the reasons provided on page 2 of the Office Action. In addition, claim 6 was rejected 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,459,220 to Kennedy ("Kennedy") or U.S. Patent No. 6,476,176 to Wu ("Wu '176"). Furthermore, claims 1-13 were rejected under § 102(e) as anticipated by or § 103(a) as obvious over U.S. Patent Publication No. 2003/0096936 to Wu ("Wu '936"). Moreover, the Examiner rejected claims 1-13 under § 102(b) or § 103(a) as anticipated or obvious over, respectively, U.S. Patent Publication No. 2002/0173379 to Wu ("Wu '379"). Finally, claims 1-13 and 28-31 were rejected under § 102(a, e) as anticipated by or § 103(a) as obvious over U.S. Patent Publication No. 2003/0144087 ("Rajagopalan '087"). None of the cited references disclose or suggest the present invention for at least the reasons that follow.

*Neither Crast Nor Kennedy Do Not Disclose or Suggest the Present Invention*

Both Crast and Kennedy are completely silent as to the features previously recited in claim 7 and now recited (at least partially) in claim 1. Thus, Applicants respectfully submit that neither Crast nor Kennedy disclose or suggest the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

*Wu '176 Does Not Teach or Suggest the Present Invention*

Wu '176 generally discloses golf ball compositions formed from saturated polyurethane components. *See* Abstract. Wu '176 does not teach or suggest, however, the trifunctional curing agents presently recited in claims 1 and 9. Thus, in light of the amendments herein, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

*Wu '936 Does Not Anticipate or Render Obvious the Present Invention*

Wu '936 is silent as to the trifunctional isocyanates now recited in claims 1 and 9. *See* Para 0019 and Para 0087. In particular, Wu '936 does not teach or suggest a prepolymer consisting essentially of urethane linkages. In fact, the Wu '936 reference is directed to prepolymers formed from isocyanates and polyether amines, *i.e.*, prepolymers containing primarily urea linkages.

With regard to the Examiner's comments regarding the availability of this reference under § 102, Applicants clarify that the comments in the previous Office Action regarding the use of Wu '936 under § 102(e) for the purposes of a rejection under § 103(a) still apply here as the Examiner has again rejected the claims under § 102 (a, e). Office Action at Page 3. Applicants recognize that the Wu '936 is available under § 102(a) for the purposes of § 103(a), but not § 102(e).

For at least the reasons discussed above, Applicants respectfully submit that Wu '936 does not anticipate or render obvious the present invention. As such, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

*Wu '379 Does Not Disclose or Suggest the Present Invention*

Wu '379 does not disclose or suggest a composition including a prepolymer and a trifunctional curing agent, as presently recited. In particular, while Wu '379 does recite some triamines for use with the isocyanate-containing compound, none of the triamines are those

included in the group recited in claims 1 and 9. *See, e.g.* Para. 0051. For at least this reason, Applicants respectfully submit that Wu '379 does not anticipate or render obvious the present invention. As such, reconsideration and withdrawal of the rejection based thereon is respectfully requested.

*Rajagopalan Is Not Prior Art to the Present Invention*

Rajagopalan generally discloses various polyurethane compositions for the cover layer of a golf ball. In addition, this reference discusses various polyurea cover formulations. While the reference does suggest that any of the polyether amines listed for use in the polyurea prepolymer may be used as curing agents to react with the *polyurea prepolymers* (Para. 0174), this same instruction does not apply to their use as curing agents for the polyurethane prepolymers. In fact, the list of curing agents for use with the polyurethane prepolymer differs from the list provided for the polyurea prepolymers. *Compare* Para. 0145-0147 and 0152 with Para. 0173-0174. As such, the Rajagopalan reference does not anticipate claims 1, 9, or 28.

Furthermore, based on the fact that there is specific teaching in this reference as to the differences between polyurethane and polyurea compositions (as well as different components discussed for each type of composition), a skilled artisan would not have been motivated to substitute the suitable curing agents listed in the Rajagopalan reference for use with the polyurethane prepolymer with those listed for use with the polyurea prepolymer absent the claims of the present invention to use as a template. *See, e.g.*, Para. 0153 (teaching that polyurea-based compositions are distinctly different from polyurethane compositions).

Moreover, with regard to claim 28, Rajagopalan does not disclose or suggest the composition presently recited. As discussed above, Rajagopalan does not teach the trifunctional curing agents presently recited for use with a polyurethane prepolymer. In addition, Rajagopalan does not teach or suggest a polyurethane prepolymer formed with the trifunctional isocyanates presently recited in the claim. In fact, the list of isocyanates provided in Rajagopalan as suitable for use in the polyurethane prepolymer do not include any of the trifunctional isocyanates presently recited in claim 28. *See* Para. 0139 and 0150. Like the trifunctional curing agent, any similarity between the trifunctional isocyanates recited in claim 28 and Rajagopalan is limited to use in a polyurea prepolymer. And, as previously discussed, based on Rajagopalan's warning about the differences between the two types of compositions, a skilled artisan would not have been motivated to stray outside the

suggested list of isocyanates for use with the polyurethane prepolymer absent the use of impermissible hindsight.

For at least these reasons, Applicants respectfully submit that the present invention is not anticipated or rendered obvious by Rajagopalan. Thus, Applicants respectfully request reconsideration and withdrawal of the §§ 102 and 103 rejections based thereon.

### **DOUBLE PATENTING REJECTION**

The Examiner rejected claims 1-8 and 28-31 under the judicially created doctrine of obviousness-type double patenting based on claim 9 of U.S. Patent No. 6,939,907. Applicants submit herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) in order to overcome the double patenting rejection based on the '907 patent. Thus, Applicants respectfully request that the double patenting rejection be withdrawn.

### **CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Petition for Extension of Time is submitted herewith to extend the time for response three months to and including November 26, 2006. In addition, a Fee Sheet Transmittal is submitted to authorize the charge for the Terminal Disclaimer, extension fee, and fee for the Request for Continued Examination. No other fees are believed to be due at this time. Should any fee be required, however, please charge such fee to Bingham McCutchen LLP Deposit Account No. 195127, Order No. 20002.0331.

Respectfully submitted,  
BINGHAM McCUTCHEN LLP

Dated: November 21, 2006

By: Stephanie D. Scruggs  
Stephanie D. Scruggs, Registration No. 54,432  
BINGHAM McCUTCHEN LLP  
3000 K Street, NW, Suite 300  
Washington, D.C. 20007  
(202) 373-6755 Telephone  
(202) 295-8478 Facsimile